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Serial no. 09/940,360
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Attorney docket no. 10018309-1

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REMARKS

Claim rejections under 35 USC 101

Claims 1-6, 7-10, and 13-15 have been rejected under 35 USC 101 as being directed to non-statutory subject matter. With respect to claim 1, from which claims 2-6 have been rejected under 35 USC 101 due to their dependence from claim 1, the Examiner states that this claim fails to produce a use result for the following reasons. First, the Examiner states that the claims appear not to yield any action due to the dependency on a device connection, such that there is no useful result when the device connection is made. Second, the Examiner states that the window is closed prior to any software for the device being fully installed, such that there is no useful result.

Applicant respectfully responds by stating that the Examiner appears to be confused to some degree as to what the subject matter of claim 1 is directed to. In this respect, Applicant has amended claim 1 to clarify its subject matter. First, claim 1 installs software on a computer for a device to be connected to the computer, "in accordance with a software-first installation mode." Now, while this software is being installed in accordance with this software-first installation mode, the method suppresses "an automatic installation/hardware-first installation mode" for the device as initiated by an operating system upon the device being connected prior to the software being completely installed on the computer "in accordance with the software-first installation mode."

Thus, the subject matter of claim 1 is as follows. Software for a device is installed on a computer in accordance with a software-first installation mode. If during such installation the device is connected to the computer, causing the operating system to start an automatic installation/hardware-first installation mode for the device, then this latter installation mode is suppressed. It is not the software-first installation mode that is suppressed, but rather the hardware-first installation mode that is suppressed. As a result, there is always a useful result afforded by performance of the method of claim 1 – the software is always installed in accordance with the software-first installation mode. If the device is connected to the computer prematurely,

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such that the operating system begins an automatic installation/hardware-first installation mode, then this latter mode is further suppressed by closing its window.

Thus, when the Examiner states that there is no useful result when the device connection is made, this is erroneous, because the software for the device is always installed on the computer in accordance with the software-first installation mode, which has nothing to do with the window that is suppressed and that is related to the hardware-first installation mode. When the Examiner states that the window is closed prior to any software for the device being installed upon connection of the device to the computer, this is also erroneous, because the software for the device is always installed in accordance with the software-first installation mode. The window that is closed has to do with the hardware-first installation mode, not the software-first installation mode.

Applicant directs the Examiner's attention to the discussion of FIGs. 1-3 in the patent application as originally filed as providing support for the amendments made to the claimed invention, and for informing the distinction between a software-first installation mode and a hardware-first installation mode in one embodiment of the invention. In particular, this discussion notes the following:

FIG. 1 shows a method 100 outlining the general process of software installation for a hardware device as may be followed and recommended by a hardware manufacturer. The method 100 is referred to as a software-first installation in that software for the device is installed on the computer before the device is connected to the computer. First, the user starts the installation of the software by running an installer program (102). The installer program may query the user as to what parts of the software available for installation the user wishes to install (104). The program copies the necessary and appropriate files to the computer (106), and then instructs the user to connect the hardware to the computer to complete the installation (108).

However, users are many times impatient, plugging the cable for the hardware into a corresponding connector of the computer before installation of the software has been completed. Alternatively, the user may simply be following the operating system's recommendation or suggestion of being able to connect the hardware to the computer before installing any software for the hardware. FIG. 2 shows a method 200 outlining what occurs when the user connects the hardware

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before the software installation of FIG. 1 has been completed. The user connects the device to the computer before being instructed to do so by the installer program (202). In response, the operating system, assuming it can immediately detect the new hardware, initiates its automatic hardware installation mode (204).

As has been indicated, the automatic hardware installation mode of the operating system may contradict the software-first installation recommended by the manufacturer of the device. The automatic hardware installation mode, also referred to as a hardware-first installation, in that the hardware is connected to the computer before the software for the hardware is installed, may present conflicting instructions to the user as compared to the software-first installation. Inexperienced and novice users may become confused, not knowing whether to follow the instructions of the software-first installation, or those of the hardware-first installation.

This scenario is depicted in FIG. 3, in which a software installation window 302 is first shown to the user in which instructions are provided by the manufacturer of the device as to installation of software for the device, such as drivers, complementary computer programs, and so on. However, if the user connects the device to the computer prior to completion of the software-first installation, a second window 304 appears. The window 304 is an automatic hardware installation window, and may overlap the software installation window 302. The instructions provided in the window 304 are given by the operating system as part of a hardware-first installation, and may contradict the instructions provided by the device manufacturer in the window 302 as part of a software-first installation.

Thus, the software-first installation mode is different than the hardware-first installation mode. Indeed, "the automatic hardware installation mode of the operating system may contradict the software-first installation recommended by the manufacturer of the device." Furthermore, the "automatic hardware installation mode, also referred to as a hardware-first installation, . . . may present conflicting instructions to the user as compared to the software-first installation." Therefore, the claimed invention is directed to suppressing the hardware-first installation of the device, while software for the device is being installed in accordance with the software-first installation for the device. These are two separate installation modes, such that there is always a useful result by performing the method of claim 1: the software of the software-first installation

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mode is always installed; where the user connects to the device prior to this software being installed, it is the hardware-first installation mode that is suppressed.

With respect to claim 7, from which claims 8-10 have been rejected under 35 USC 101 due to their dependence from claim 7, the Examiner similarly states that as "a whole, the installation for a device that is yet to be connected amounts to detecting a particular window related to the installation of said device and closing it." As such, the Examiner states that it "is hard for one skill[ed] in the art to perceive that by closing such a window any software related to the device has been installed by the claimed invention," such that the "claim amounts to a mere concept . . . because the claim fails to convey that a concrete and useful result has been achieved."

With respect to this claim as well, Applicant respectfully submits that the Examiner is misunderstanding what the subject matter of claim 7 is. Applicant has amended claim 7 so that it is more clear that software is installed on the computer for the device in accordance with a software-first installation mode. If a new window is launched that is associated with a hardware-first installation mode being initiated by the operating system, prior to the software being installed in accordance with the software-first installation mode, then it is this new window, and hence the hardware-first installation mode, that is suppressed. The software associated with the software-first installation mode is always installed, such that there is always a concrete and useful result being achieved. This software installation is never suppressed or aborted, but rather only a hardware-first installation mode is aborted or suppressed if such a hardware-first installation mode is initiated by the operating system.

Finally, with respect to claim 13, from which claims 14-15 have been rejected under 35 USC 101 due to their dependence from claim 13, the Examiner likewise states that "the combination of a device and computer for enabling a suppression of a window upon the device being inserted is only operative upon the connection of the device to the computer." As such, the Examiner concludes that this "leaves the possibility that if the device is connected, there will be no closing [of a window], hence no concrete result." The Examiner also states that the "other

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possibility, in case there is connection and closing of the installation of the installation window . . . do[es] no[t] amount to [a] useful result.”

Applicant has correspondingly amended claim 13 as has been described in relation to claims 1 and 7. The means of claim 13 is for “installing software on the computer for the device, in accordance with a software-first installation mode.” Thus, software is always installed on the computer for the device, in accordance with this software-first installation mode, hence there is always a concrete and useful result. The means is further for suppressing an “automatic installation/hardware installation mode . . . upon the device being connected to the computer prior to the software being completely installed in accordance with the software-first installation mode.” Thus, where the device is connected to the computer before the software is completely installed in accordance with the software-first installation mode, then this automatic installation/hardware installation mode is that which is suppressed – that is, the software-first installation mode is not suppressed, and the software in accordance with this mode is still installed, such that there is still a concrete and tangible result.

Claim rejections under 35 USC 112

Claim 6 has been rejected under 35 USC 112, second paragraph, as being indefinite, because the limitation recites “after instructing the user to connect the device,” whereas there is no previous recitation that the user has been instructed to connect the device. Applicant has amended this claim so that it recites the method further comprising “instructing the user to connect the device to the computer, and waiting for the user to confirm that the device is connected to the computer.” As such, claim 6 is no longer indefinite, and Applicant requests withdrawal of this rejection.

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Claim rejections under 35 USC 102

Claims 1-5, 7-13, and 15 have been rejected under 35 USC 102(a) as being unpatentable over Fida International, Prolink User's Manual. Claims 1, 7, and 13 are independent claims, from which the remaining pending claims ultimately depend. Applicant asserts that claims 1, 7, and 13 are patentable over Fida, such that all of the pending claims rejected on this basis are patentable over Fida.

Applicant discusses claim 1 as representative of all the independent claims 1, 7, and 13, insofar as patentability over Fida is concerned. Applicant submits that Fida does not disclose the suppression of an automatic installation/hardware-first installation mode for a hardware device, by detecting and in response closing a window, where such window DETECTION and responsive closure is performed by "COMPUTER INSTRUCTIONS executed by a processor of the computer." That is, in the claimed invention, *COMPUTER INSTRUCTIONS*, executed by a processor, *DETECT* and *in response* close the window associated with the automatic installation/hardware-first installation mode.

By comparison, Fida only discloses the suppression of an automatic installation mode via *a user detecting* and in response causing the closing of a window related to the automatic installation mode, as opposed to *computer instructions executed by a processor of the computer* detecting and in response closing this window. In section 3.1.1, page 7 of Fida, the user is instructed to "click 'cancel' to exit from the new hardware installation wizard," where the new hardware installation wizard is an automatic installation mode for a hardware device. That is, the user has to click the cancel button on the window in order to suppress the automatic installation mode. *As such, the user inherently DETECTS the window him or herself – there are no computer instructions execution by a processor of the computer that performs this detection.* In response to the user pressing the cancel button in Fida, only then do the computer instructions close the window. Therefore, Fida does not teach all the limitations of the claimed invention, since the claimed invention is limited to the suppression of the automatic installation mode by

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computer instructions executed by a processor of the computer detecting and in response closing a window related to the automatic installation mode.

The Examiner notes that Fida's "underlying window code that takes away a CANCEL button related to a verbose installation mode reads on computer executed instructions in the course of the detection of a[n] autorun mode capability." (Office action, p. 6) However, computer instructions "taking away" a CANCEL button, presumably as part of closing the window of which this button is a part from being displayed is not in response to the computer instructions detecting a window. Rather, the computer instructions close the window in response to the user in Fida detecting the window and clicking the CANCEL button.

Applicant respectfully reminds the Examiner that Fida is to be interpreted not in light of the claimed invention, but rather by one of ordinary skill within the art. Therefore, where Fida instructs a user in a user manual to "Click 'Cancel' to exit the New Hardware installation wizard," one has to ask whether it is a user that detects the window of which the installation wizard and the cancel button are a part, or whether it is computer instructions that detect this window. There can be no doubt that it is the user in Fida that detects the window, insofar as the Fida manual itself is asking the user to click cancel button upon the user seeing or recognizing (i.e., detecting) the window.

The computer instructions in Fida may close the window in response to the user detecting the window and clicking the cancel button, but this is not what the claimed invention is directed to. Rather, the claimed invention has computer instructions detecting a window and *in response to the computer instructions detecting the window*, the computer instructions closing the window. In Fida, a user detects the window, clicks the cancel button, *and in response to the user clicking the cancel button*, the computer instructions close the window. There is no way one of ordinary skill within the art would equate Fida's user detecting a window and clicking a cancel button, and in response Fida's computer instructions closing the window, as reading upon the claimed invention's computer instructions detecting the window and in response closing the window.

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Fida in actuality presents a less user-friendly solution to the problems associated with the prior art. The patent application as filed, as has been excerpted above, notes that the automatic hardware installation/hardware-first installation mode may conflict or present conflicting instructions as compared to the software-first installation mode. As such, inexperienced and novice users may become confused, not knowing whether to follow the former installation mode or the latter installation mode. Fida solves this problem by having a user manual that explicitly instructs the user to detect the hardware-first installation mode and cause this mode to be suppressed by clicking the cancel button on the window associated with this mode.

However, as the Examiner is no doubt aware, many users never read their user manuals. Therefore, the claimed invention provides a different way to solve this problem. In the claimed invention, rather than having a user detect the hardware-first installation mode, the computer instructions themselves detect a window associated with the hardware-first installation mode and close this window to suppress the hardware-first installation mode. Even if a user does not read the instruction manual, proper software-first installation mode software for the device is installed. This is in contradistinction to Fida, where if the user does not read the manual, the user may not know to close the hardware-first installation mode window. Indeed, even if the user has read the manual in Fida, he or she may still go against the instructions and not close the hardware-first installation mode window – a problem that never occurs in the claimed invention.

For all of these reasons, then, Fida cannot be considered as anticipating the claimed invention.

Claim rejections under 35 USC 103

Claims 6 and 14 have been rejected under 35 USC 103(a) as being unpatentable over Fida in view of Polycom, ViaVideo User's Guide. Claims 6 and 14 are dependent claims, depending from the independent claims rejected over Fida alone under 35 USC 102(a). Therefore, Applicant

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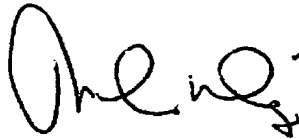
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submits that claims 6 and 14 are patentable, at least because they depend from patentable base independent claims, as discussed above.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

Michael A. Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

Law Offices of Michael Dryja
704 228th Ave NE #694
Sammamish, WA 98074
tel: 425-427-5094
fax: 206-374-2819